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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,022	01/28/2002	William E. Sonnier	forbes-pitchextr	4919
26133 7590 07/02/2009 THOMPSON & KNIGHT, L.L.P. PATENT PROPERTY DEPARTMENT 1722 ROUTH STREET, SUITE 1500 DALLAS, TX 75201-2533				
EXAMINER				
BADJO, BARBARA P				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
07/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/060,022

Applicant(s)

SONNIER ET AL.

Examiner

Barbara P. Badio

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Final Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Status of the Application

2. Claims 1-19 are pending in the present application and are rejected as indicated below.

Claim Rejections - 35 USC § 112

3. The rejection of claim 16 under 35 USC 112, second paragraph is withdrawn.

Claim Objections

4. The objection to claim 19 under 37 CFR 1.75(c), as being of improper dependent form is withdrawn.

Claim Rejections - 35 USC § 103

5. The rejection of claims 1-19 under 35 USC 103(a) over Wong et al. (WO 99/42471) is maintained.

Applicant argues that there are two main differences between the cited reference and the instant claims: (a) distillation of the pitch to remove excess rosin acids and fatty

acids before saponification and (b) the neutralization step of the saponified pitch ends with a pH of between 5.8 and 6.3. Applicant's argument was considered but not persuasive for the following reasons.

First, according to applicant, the presaponification distillation advantageously removes excess rosin acids and fatty acid such that the subsequent saponification step is more efficient. However, Wong teaches the isolation of phytosterol from either tall oil soap or from *tall oil pitch which contains small amount of fatty and rosin acids* along with a substantial amount of the original unsaponifiables (see page 1, lines 20-24). Thus, the reference teaches the use of a starting material with small amount of fatty and rosin acids. Additionally, as noted in the previous Office Action, the use of a pure starting material in order to improve the purity of the desired end product is well known in the chemical art and, thus, would have been obvious to the skilled artisan in the art at the time of the present invention. Therefore, the further purification of the tall oil pitch in order to further lower the amount of fatty and rosin acids before use in the process of Wong is *prima facie* obvious.

Secondly, as noted by applicant, Wong teaches a pH range of between 4 and 7, preferably between 5 and 7 and exemplifies a pH of 6.4. However, according to applicant, there is no suggestion of the advantage of this pH nor does Wong suggests limiting the pH to the claimed range to effectuate an improvement in the subsequent water removal steps and reduce catalyzation of the reversion of the free sterols to their esterified form. However, there is no requirement that the prior art suggests the same reason or motivation for an ending pH of between 5.8 and 6.3 during the neutralization

step as discovered by applicant. The claimed pH range is obvious based on the fact that the Wong teaches a pH range of between 4 and 7, preferably between 5 and 7 and exemplifies a pH of 6.4.

For these reasons and those given in the previous Office Action, the rejection of claims 1-19 under 35 USC 103(a) over Wong et al. (WO 99/42471) is maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/
Primary Examiner, Art Unit 1612